

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CAMILLO MORO

Appeal No. 1998-3305
Application No. 08/381,886¹

ON BRIEF

Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 8 through 13, which are all of the claims pending in this application.²

¹ Application for patent filed February 22, 1995.

² Claims 8, 10, 11 and 13 were amended subsequent to the final rejection. In view of these amendments, the examiner withdrew the rejection of claims 8 through 13 under 35 U.S.C. § 112, second paragraph (see Paper No. 12, mailed August 19, (continued...))

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We REVERSE.

²(...continued)
1997).

BACKGROUND

The appellant's invention relates to a feeding duct for writing instruments (claims 10 through 13) and a method of producing a feeding duct for writing liquids (claims 8 and 9). An understanding of the invention can be derived from a reading of exemplary claims 8 and 10, which appear in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wada et al. (Wada) 1992	5,087,144	Feb. 11,
Miltner	1,214,113 ³ (Germany)	Sep. 25, 1959
Rott et al. (Rott)	3,931,161 ⁴ (Germany)	Mar. 28, 1991

³ In determining the teachings of Miltner, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellant's convenience.

⁴ In determining the teachings of Rott, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellant's convenience.

Claims 8 through 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rott in view of Wada and Miltner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 16, mailed April 30, 1998) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 14, filed June 27, 1997) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will

not sustain the examiner's rejection of claims 8 through 13 under

35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071,

1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on

§ 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

With this as background, we turn to the examiner's rejection of the claims on appeal. The examiner determined

(answer, p. 3) that (1) Rott "discloses substantially similar structure,"⁵

(2) Wada "discloses forming in two sections an internal channel," and (3) Miltner "discloses the equivalence between a groove and internal channel." The examiner then concluded (answer, pp. 3-4) that

[i]t would have been obvious to a mechanic with ordinary skill in the art to provide these features to the primary reference. The motivation is to aid in manufacturing, and to convert to a felt tip.

The appellant argues (brief, pp. 4-5) that "the claimed invention could not be obvious from the art of record" since the references, together or separately, do not teach all of the limitations of the claims under appeal. We agree.

All the claims under appeal require that a groove be formed when opposing recesses in two distinct portions are secured one to another. However, this limitation is not

⁵ We presume that the examiner was comparing the claimed subject matter to the subject matter disclosed in Rott in making this determination.

suggested by the applied prior art. In that regard, while Miltner does teach two distinct portions secured together and Wada does teach the use of split molds to form an ink storage member, it is our opinion that such teachings would have been insufficient to have motivated an artisan to have modified Rott's ink conductor 16 in the manner proposed by the examiner to arrive at the claimed invention.

In our view, the only suggestion for modifying Rott in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejection of claims 8 through 13.

CONCLUSION

To summarize, the decision of the examiner to reject
claims 8 through 13 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JEFFREY V. NASE)	
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APPLICATION NO. 08/381,886

APJ NASE

APJ ABRAMS

APJ COHEN

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 01 Jun 99

FINAL TYPED: